

REMARKS

Applicant has carefully reviewed the office action of 26 March 2003 and offers the following remarks. Before addressing the merits of the rejection, Applicant provides a summary of the present invention to provide context for the remainder of the remarks.

The present invention is a system by which users may receive information based on time, location and event triggers. Specifically, to preclude information delivery at inappropriate times, the user may define a profile that outlines when certain types of information are to be delivered. The example in the specification is that stock updates are not desired while working, but are appropriate for delivery during the commute. Thus, the user defines a time period and a location parameter in which the service provides the stock updates. This way, the user does not receive the stock updates while working.

Claims 1, 4-7, 17, 20, and 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Amin et al. Applicant respectfully traverses. For the Patent Office to establish a proper case for anticipation, the Patent Office must show where each and every claim element is located in the reference, and the elements must be arranged as claimed. MPEP § 2131. If the Patent Office does not show where each and every element is, the Patent Office has not shown how the claim is anticipated, and the claim defines over the rejection.

In the present case, each of the independent claims recites an element which is not shown or suggested by the reference, and thus, the Patent Office has not established *prima facie* obviousness, much less anticipation. Claim 1, recites "sending information to a select communication device when the event occurrence and the location indicia correlate with an event criteria and location criteria **defined in a profile.**" The Patent Office opines that this element is taught in Figs. 1-4, column 1, lines 45-50 and column 2, line 53-column 3, line 47. Applicant has studied the cited passages and figures and finds no teaching or suggestion of a profile therein. The passage from column 1 recites that geographically relevant information is provided, but does not provide any indication that the geographic information is linked in any manner to a profile. The passage in columns 2 and 3 likewise does not teach or suggest a profile. In contrast, this passage actually confirms that there is no profile since the model used to provide information is a push model. For example, the reference states "whenever a location-specific user is located within a particular region, the directed information system may automatically transmit the region-specific information to the location directed by the user." (Column 3, lines

12-15). Such automatic transmission would defeat the purpose of the profile which precludes information from being sent at an inappropriate time. The reference's other examples of the motor oil sale, the restaurant and car dealership also are linked to the push model and thus are not defined by a profile. This information is provided to the user without the user's input and without any consideration of a profile. Thus, it is clear that the reference does not teach the recited profile and the claim is not anticipated by the reference.

Applicant appreciates the telephonic conversation with the Examiner on 25 April 2003 when Applicant's representative asked the Examiner where the profile could be found in the reference. The Examiner indicated that column 1, lines 55-62 teach a profile. Applicant respectfully disagrees. Merely storing a message in a web page or email system is not the same as the recited profile. Likewise, observing a menu is not the same thing as the recited profile. The profile defines event criteria and location criteria that cause information to be sent to the device and is not merely the information that can be sent to the device.

Claims 17 and 23 are grouped with claim 1 in the Patent Office's analysis, and in relevant part, the claims are identical. Specifically, claims 17 and 23 recite the same profile recited by claim 1. The reference fails to teach this profile, and thus, claims 17 and 23 are likewise not anticipated by the reference.

Claims 4-7 depend from claim 1 and include the profile recited in claim 1. Because the reference does not teach the recited profile, claims 4-7 are likewise not anticipated by the reference.

Claim 20, in relevant part, is identical to claim 1 in that the profile is recited. The Patent Office adds the passage at column 4, line 51 to column 6, line 10 to the analysis of the profile passage. This additional passage does not disclose a profile, but rather describes various computer configurations that may be acceptable. Thus, nothing in the Patent Office's analysis of claim 20 provides the missing profile that is recited in the claim. Since the Patent Office has not shown where the recited profile is within the claim, claim 20 is likewise not anticipated by the reference.

Claims 2, 3, 11-16, 18, 19, 21, and 22 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the reference each and every element is taught or suggested. MPEP § 2143.03. If the Patent Office cannot show where

each and every element is taught or suggested, the claim is not obvious. Where the Patent Office modifies a single reference to construct an obviousness rejection, the Patent Office must make particularized findings about the motivation to modify the reference. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The Patent Office, in its analysis of claims 2 and 3, does not address the recited profile element, and thus, has not shown where the profile element is taught or suggested. Since the Patent Office has not shown where the profile element is taught or suggested, the Patent Office has not established *prima facie* obviousness, and these claims are not obvious in light of the rejection put forth by the Patent Office. Furthermore, the Patent Office would have to modify the reference to include the profile, and the Patent Office has not set forth the particularized findings required by *Dembiczak*. In short, the Patent Office has not met its burden in proving these claims obvious over the references of record.

As further evidence that the claims are non-obvious over the rejection of record, claim 2 recites "identifying the profile defining the event criteria corresponding to the event occurrence" Since the reference does not teach or suggest a profile, there can be no identification of the profile. Further, if the reference does teach a profile, there is still no teaching or suggestion that the profile is identified.

Likewise, with respect to claims 11-16, 18, 19, 21, and 22, these claims depend directly or indirectly from a claim that recites the profile. Nothing in the Patent Office's analysis shows where the recited profile is taught or suggested. Thus, the Patent Office has not established *prima facie* obviousness, and the claims are not obvious in light of the rejection.

Claim 13 deserves special mention in that claim 13 recites that the profile is user defined. The Patent Office opines that the user requesting information through a webpage or email system meets the limitation. Applicant respectfully traverses. Merely requesting information is not defining a profile as that term is used herein.

Claims 8-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. in view of Asaoka et al. Applicant respectfully traverses. The standard for obviousness is set forth above. Claims 8-10 depend directly or indirectly from claim 1 and thus include the profile limitation recited in claim 1. The Patent Office's analysis of claims 8-10 does not show where the recited profile is taught or suggested, and thus, the Patent Office has not established *prima*

facie obviousness for claims 8-10. Since the Patent Office has not established *prima facie* obviousness for claims 8-10, the claims are not obvious.

Applicant requests reconsideration of the rejections set forth in the Office Action of 26 March 2003. Specifically, the Patent Office is invited to show where the profile limitation recited in all of the presented claims may be found or suggested in the references. If the Patent Office cannot find such a limitation, the claims are patentable as filed and Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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